



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Seguin et al. GROUP: 2876  
SERIAL NO: 10/056,352 EXAMINER: K. Koyama  
FILED: January 24, 2002  
FOR: TEST TUBE WITH DATA MATRIX CODE MARKINGS

Honorable Commissioner of  
Patents and Trademarks  
Mail Stop Appeal Briefs  
P.O. Box 1450  
Arlington, VA 22313-1450

Sir:

APPEAL BRIEF

RECEIVED  
JUN - 3 2003  
TECHNICAL STAFF 2800

Pursuant to 35 U.S.C. §134 and 37 C.F.R. §§1.191, 1.192 and 1.196, Appellants' respectfully appeals to the Board of Patent Appeals and Interferences from the Examiner's final rejection of applicant's Patent Application Ser. No. 10/056,352 filed January 24, 2002.

**1. REAL PARTY IN INTEREST**

The real party in interest in the present case is the Assignee, Matrix Technologies Corporation.

**2. RELATED APPEALS AND INTERFERENCES**

The present application has no pending related appeals or interferences.

**3. STATUS OF CLAIMS**

Claims 22-32 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Wijnschenck et al. (U.S. Patent 6,270,728) in view of Moh et al. (U.S. Patent 6,165,594).

Claims 33-36 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Wijnschenck et al. (U.S. Patent 6,270,728) in view of Moh et al. (U.S. Patent 6,165,594) and Mizobuchi et al. (U.S. Patent 6,133,342).

#### **4. STATUS OF AMENDMENTS**

No amendments after the final rejection have been filed.

#### **5. SUMMARY OF THE INVENTION**

The present invention is directed to a test tube 10 comprising a tube body of unitary construction. The tube body comprises enclosed sidewall 12 and an integral bottom that together define a tubular container having an open top 16. The bottom has an exterior surface 14 upon which machine readable data 21 is encoded within an opaque coating deposited onto the exterior surface 14 to uniquely identify the test tube 10. See specification at page 4, lines 10-21, bridging to page 5, lines 1-4, page 6, lines 18-21 and Figs. 1-3.

The invention is also directed to a method of manufacturing a test tube comprising the steps of providing a tube body of unitary construction comprising an enclosed sidewall with an open top and an integral bottom with an exterior surface, applying an opaque coating to the exterior surface and encoding machine readable data within the opaque coating. See specification at page 5, lines 5-21, bridging to page 6, lines 1-21, bridging to page 7, lines 1-5.

#### **6. ISSUES**

The issue before the Board in this appeal is whether the Examiner was correct in rejecting independent claims 22 and 29 under 35 U.S.C. 103(a) as being unpatentable over Wijnschenck et al. in view of Moh et al., the remaining dependent claims being rejected on the same or primarily the same premise as that of claims 22 and 29.

#### **7. GROUPING OF CLAIMS**

For the purpose of this appeal, claims 22-36 stand or fall together.

8. ARGUMENT

Claim 22 claims a test tube having a unitary construction, with machine readable data encoded within an opaque coating deposited onto the exterior surface of the tube bottom.

Claim 22 stands finally rejected as being obvious over Wijnschenk et al. in view of Moh et al. Wijnschenk et al. teaches machine readable data encoded on a separate carrier part 6 attached to a test tube bottom. Moh et al. teaches a temperature resistant label that is attachable to a substrate. Neither Wijnschenk et al. or Moh et al., either when viewed singly, or in combination, disclose or suggest the unitary test tube concept claimed in claim 22, where the machine readable data is encoded within an opaque coating on the exterior bottom surface of the test tube. It follows, therefore, that the Examiner's rejection should be withdrawn, and this case passed to issue.

There is ample precedent for doing so. This application is a continuation of U.S. Pat. Appln. Ser. No. 09/399,404 (hereinafter referred to as "the '404 application"), now U.S. Pat. 6,372,293 (hereinafter referred to as the '293 patent"), a copy of which is attached hereto as Exhibit A. Claim 1 of the '293 patent reads as follows:

A test tube, comprising:

a tube body of unitary construction comprising an enclosed sidewall and an integral bottom that together define a tubular container having an open top, wherein said bottom has a concave interior surface and a planar exterior surface upon which machine readable data is encoded within multi-layered opaque coatings of contrasting colors that are deposited onto said planar exterior surface to uniquely identify said test tube. [emphasis added]

During prosecution of the '404 application, this claim was rejected under 35 U.S.C. §103 as being unpatentable over WO/9805427 (hereinafter "the '427 application"), attached hereto as Exhibit B, in view of Moh et al. See Exhibit C attached hereto. The '427 application is the same as Wijnschenk et al. In response to the rejection of claim 1, Appellants submitted arguments to overcome the obviousness rejection of claim 1. See Exhibit D attached hereto. The Examiner ultimately allowed claim 1 after recognizing that the primary issue in regard to the patentability of claim 1 was whether the '427 application in view of Moh et al. taught or suggested a test tube of unitary construction. See Exhibits E and C attached hereto. Although claim 22 is broader than claim 1, the same "unitary construction" issue is present here, and pursuant to the doctrine of *res judicata* the Examiner should be precluded from departing from the Patent Office's previous decision.<sup>1</sup>

---

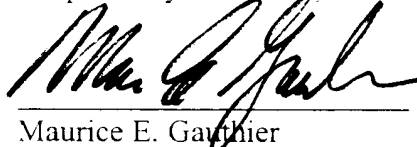
<sup>1</sup> The doctrine of *res judicata* is not only applied to judicial court proceedings but is also applied to quasi-judicial action

Claim 29 is directed to a method which comprises the steps of providing a tube body of unitary construction having a bottom exterior surface, applying an opaque coating to the exterior surface and encoding machine readable data within the opaque coating. For the reasons discussed above, it is respectfully submitted that Wijnschenk et al., either alone or in combination with Moh et al., fails to teach or suggest a method of manufacturing a test tube comprising at least the steps of providing a test tube having a tube body of unitary construction.

### SUMMARY

For all of the foregoing reasons, Appellants respectfully requests that the Board of Patent Appeals and Interferences reverse the Examiner's final rejection of claims 23, claims 24-28 and 33-36 dependent thereon, claim 29 and claims 30-33 dependent thereon.

Respectfully submitted,



Maurice E. Gauthier  
Registration No. 20,798  
Samuels, Gauthier & Stevens  
225 Franklin Street, Suite 3300  
Boston, Massachusetts 02110  
Telephone: (617) 426-9180, Ext. 113

---

in the Patent Office. Overland Motor Company v. Packard Motor Company et al., 274 U.S. 417 (1927). The issuance of '293 patent, a quasi-judicial action by the Patent Office, waives the right of the Patent Office to raise identical issues in a continuation application, which claims priority from the issued patent, that were finally decided during the prosecution of the issued patent. Id. at 421.

9. APPENDIX

APPEALED CLAIMS

1           22.    A test tube, comprising:  
2                a tube body of unitary construction comprising an enclosed sidewall and an integral bottom  
3   that together define a tubular container having an open top, wherein said bottom has an exterior  
4   surface upon which machine readable data is encoded within an opaque coating deposited onto said  
5   exterior surface to uniquely identify said test tube.

1           23.    The test tube of claim 22, wherein said opaque coating comprises: a first layer of  
2   light colored opaque material deposited onto said exterior surface; and a second layer of dark  
3   colored opaque material deposited onto said first layer, with select portions of said second layer  
4   having been removed to define said machine readable data.

1           24.    The test tube of claim 22 wherein said machine readable data is encoded by  
2   exposing said coating to a coherent light source.

1           25.    The test tube of claim 23 wherein said machine readable data is encoded by  
2   removing selected portions of said second layer to expose underlying portions of said first layer.

1           26.    The test tube of claim 25 wherein the selected portions of said second layer are  
2   removed by exposure to a coherent light source.

1           27.    The test tube of claim 23 wherein said first layer is white and said second layer is  
2   black.

1           28.    The test tube of claims 23 or 27 wherein said first and second layers comprise metal  
2    foils.

3           29.    A method of manufacturing a test tube, comprising the steps of: providing a tube  
4    body of unitary construction comprising an enclosed sidewall with an open top and an integral  
5    bottom with an exterior surface;

6           applying an opaque coating to said exterior surface; and  
7           encoding machine readable data within said opaque coating.

1           30.    The method of claim 29 wherein the application of said opaque coating comprises  
2    the steps of:

3           a)     depositing a first layer of opaque material onto said exterior surface; and

4           b)     depositing a second layer of opaque material onto said first layer, wherein said first  
5    and second layers are of contrasting colors.

1           31.    The method of claim 30 wherein said first and second layers comprises metal foils  
2    deposited by hot stamping.

          32.    The method of claim 29 wherein said machine readable data is encoded by exposing  
selected portions of said opaque coating to a coherent light source.

1           33.    The test tube of claim 24 wherein said opaque coating undergoes a change in  
2    color when exposed to said coherent light source.

1           34.    The test tube of claim 33 wherein said opaque coating includes a light sensitive  
2 pigment that undergoes said change in color.

1           35.    The method of claim 32 wherein said opaque coating undergoes a change in  
2 color when exposed to said coherent light source.

1           36.    The method of claim 35 wherein said change in color is effected by altering the  
2 color of a light sensitive pigment included in said opaque coating.



15-30-03

5043CON

111 \$  
2876

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Morris et al. GROUP: 2876

SERIAL NO: 10/056,352 EXAMINER: Unknown

FILED: January 24, 2002

FOR: TEST TUBE WITH DATA MATRIX CODE MARKINGS

Honorable Commissioner of  
Patents and Trademarks  
P.O. Box 1450  
Alexandria, VA 22313-1450

**TRANSMITTAL OF APPEAL BRIEF (PATENT APPLICATION--37 CFR 192)**

1. Transmitted herewith in triplicate is the APPEAL BRIEF in this application with respect to the Notice of Appeal filed on March 31, 2003.

NOTE: "The appellant shall, within 2 months from the date of the notice of appeal under 1.191 in an application, reissue application, or patent under reexamination, or within the time allowed for response to the action appealed from, if such time is later, file a brief *in triplicate*." 37 CFR 1.192(a) [emphasis added]

2. STATUS OF APPLICANT

This application is on behalf of  
☒ other than a small entity  
  
☐ small entity  
verified statement:  
  
☐ attached  
  
☐ already filed

3. FEE FOR FILING APPEAL BRIEF

Pursuant to 37 CFR 1.17(f) the fee for filing the Appeal Brief is:

☐ small entity \$160.00  
☒ other than a small entity \$320.00

Appeal Brief fee due \$ 320.00

RECEIVED  
JUN -3 2003  
TECHNICAL SERVICES DIVISION 2800

CERTIFICATE OF MAILING (37 CFR 1.8(a))

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the United States Postal Service on May 29, 2003 in an envelope as "Express Mail Post Office to Addressee" Mailing Label Number EL 754088906 US addressed to the: Commissioner of Patents, P.O. Box 1450 Alexandria, VA 22313-1450

Dana Casterlin

5/29/03  
date



4. EXTENSION OF TERM

NOTE: The time periods set forth in 37 CFR 1.192(a) are subject to the provision of 1.136 for patent applications. 37 CFR 1.191(d). Also see Notice of November 5, 1985 (1060 O.G. 27).

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136 apply.

*(complete (a) or (b) as applicable)*

- (a) ☐ Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-d)) for the total number of months checked below:

Extension (months)	Fee for other than small entity	Fee for small entity
<input type="checkbox"/> one month	\$110.00	\$55.00
<input type="checkbox"/> two months	\$390.00	\$195.00
<input type="checkbox"/> three months	\$930.00	\$465.00
<input type="checkbox"/> four months	\$1,470.00	\$735.00
		Fee \$

If an additional extension of time is required please consider this a petition therefor.

*(check and complete the next item, if applicable)*

- ☐ An extension for \_\_\_\_\_ months has already been secured and the fee paid therefor of \$ \_\_\_\_\_ is deducted from the total fee due for the total months of extension now requested.

Extension fee due with this request \$

or

- (b) ☒ Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

5. TOTAL FEE DUE

The total fee due is:

Appeal brief fee \$ 320.00  
Extension fee (if any) \$

TOTAL FEE DUE \$ 320.00

6. FEE PAYMENT

X Attached is a check in the sum of \$ 320.00.

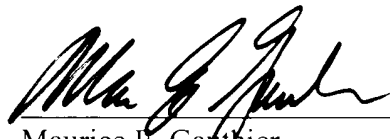
— Charge Account No. 19-0079 the sum of \_\_\_\_\_.  
A duplicate of this transmittal is attached.

7. FEE DEFICIENCY

NOTE: If there is a fee deficiency and there is no authorization to charge an account, additional fees are necessary to cover the additional time consumed in making up the original deficiency. If the maximum, six month period has expired before the deficiency is noted and corrected, the application is held abandoned. In those instances where authorization to charge is included, processing delays encountered in returning the papers to the PTO Finance Branch in order to apply these charges prior to action on the cases. Authorization to charge the deposit account for any fee deficiency should be checked. See the Notice of April 7, 1986, 1065 O.G. 31-33.

X If any additional extension and/or fee is required, this is a request therefor and to charge Account No. 19-0079.

Respectfully submitted,



Maurice E. Gauthier  
Registration No. 20,798  
Samuels, Gauthier, & Stevens  
225 Franklin Street, Suite 3300  
Boston, Massachusetts 02110  
Telephone: (617) 426-9180, Ext. 113